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EXAMINER

ABDI, KAMBIZ

ART UNIT PAPER NUMBER

3621

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/710,306

Applicant(s)

SAKO, KAZUE

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7,9-14 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-7,9-14 and 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- Claims 1, 8, and 15 are canceled.
- Claims 2, 9, and 16 are amended.
- Claims 2-7, 9-14, and 16-22 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3 March 2005 has been entered.

Response to Arguments

3. Applicant's arguments with respect to claims 2, 9, and 16 have been considered but are moot in view of the new ground(s) of rejection.

4. Applicant's arguments filed 31 January 2005 have been fully considered but they are not persuasive under the new grounds of rejection.

5. However the examiner to better clarify the position of the office has provided a new grounds of rejection based on a new art that is more clear than prior arts of record on disclosing the claimed inventive step of "the present invention does not require a data center". Additionally, the following reply was provided to the applicant in response to applicants argument regarding rejection of Claims 2, 9, and 16 under 35 U.S.C. § 103 (a) in the final office action mailed on 28 October 2004;

6. The examiner believes that the argument that the applicant has put forward on regards to claims 1, 8, and 15 are not persuasive to overcome the prior art of record. The reasoning behind the argument by the applicant is that the claims recite, "the present invention does not require a data center". Applicant is claiming that either Lee or Pierce references, either individually or in combination, do not disclose the

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above-mentioned limitation of the claims 2, 9, and 16. Examiner disagrees with the applicant and would like to bring the attention of the applicant to the fact that Lee clearly teaches the use of serial number in the revenue stamp and the utilization of such serial number in the process of the revenue stamp (See Lee figure 8, column 8, lines 31-41 and 52-59), as well as that Pierce clearly discloses that signature is created using information derived from the information available at the PSD. It clearly is different signature seed for each transfer of funds as the other data used in each signature can be different so the number of signature can be an infinite number. This information being indicia-related data generated at the Host PC, verifiable at another system (here the data center) (See Pierce column 4, lines 42-64, and column 5, line 64-column 6, line 8). As it is clear by Pierce teaching any data, which produces an invalid indicia that can be verified for its signature as a valid fund transfer indication is acceptable. There is no positive language reciting that no data center is required in the current form of the claims.

7. Further, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., data center, without communication with a uniquely managed body, or who signing the signature can be different) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. Claims 2, 9, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. The claim at paragraph 3 (a balance amount reducing means...) is not clear how the reducing means deducts the amount from the prepaid amount. There is no indication of knowledge of the amount that is needed to be deducted.

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11. The claim at paragraph 4 (a verifying means...) it is not clear how the verification is conducted there is no indication of how this step of verification of either the signature or the digital certificate takes place. Does the applicant mean; digital certificate containing a digital signature of said receiver, which is used to verify said digital certificate is valid or not...

12. The claim at paragraph 5 (an amount increasing means...) is not clear how is the prepaid amount is decreased at the balance amount reducing means and then increasing the same prepaid amount after verification. It seems to the examiner these steps are counterintuitive.

13. Clarifications of above issues are requested.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2-7, 9-14, 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,285,990 to David K. Lee et al. in view of U.S. Patent 6,058,384 to Perry A. Pierce et al. and U.S. Patent 6,427,139 to Perry A. Pierce.

16. As per claims 2, 9, and 16, Lee discloses an electronic revenue stamp issuing apparatus, method, and storage device, comprising:

- a judging means for judging whether the amount of an electronic revenue stamp to be issued is equal to or less than a prepaid amount (See Lee figures 2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63);
- an issuing means for issuing said electronic revenue stamp as data on a document (See Lee figures 2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63), said issuer means giving a serial number with said data to said electronic revenue stamp,

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said data containing a digital signature of said electronic revenue stamp issuing apparatus on a message, said message including the document which said electronic revenue stamp is attached to, the amount of said electronic revenue stamp (See Lee figures 2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63), and an identifier of a receiver of said electronic revenue stamp, if said amount of said revenue stamp is judged to be equal to or less than said prepaid amount (See Lee figures 2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63);

- a balance amount reducing means for reducing said amount of said electronic revenue stamp from said prepaid amount if said electronic revenue stamp is issued (See Lee figures 2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63, column 6, lines 1-68, and column 7, lines 1-25);

What is not clear and explicit in Lee is the usage of the signature for further security and additional information transfer within the indicia. Lee clearly discloses the use of digital token as means of secure transaction within the metering system and record keeping for further tracking of indicia issuing and book keeping.

However, Pierce (384) clearly teaches the steps of using specifically a digital signature in order for further securing issuance and refunding of revenue stamps (See Pierce (384) figure 2 and associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce teachings for creating revenue stamps and a more efficient, less processing time, and better security control of refunding unused revenue stamps.

Additionally, what Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- a verifying means that is part of the stamp issuing apparatus, wherein said verifying means receives a digital certificate from said receiver making an electronic revenue stamp invalid, containing a digital signature of said receiver, and varies whether said distal certificate making said electronic stamp invalid is valid or not by using said identifier of said receiver and without

communication with a data center; (See Pierce (384) abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53 and Pierce (139) figure 3 and column 2, lines 53-65 and column 3, lines 10-15);

- an amount increasing means for increasing said prepaid amount (See Pierce (384) abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53); and
- an invalid electronic revenue stamp recording means for recording said distal certificate making an electronic revenue stamp invalid (See Pierce (384) abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

What is not clear and explicit in Lee and Pierce (384) is the existence of communication or lack of it in the verification step of above claimed invention. However, Pierce (139) clearly teaches and discloses a system and method to make a verification of the digital certificate and the signature without communication with a data center.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and the two Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

17. As per claims 3, 10, and 17, Lee and Pierce teach all the limitations of claims 1, 8, and 15 further;

What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- said issuing means issues an issue number of said electronic revenue stamp issuing apparatus to said electronic revenue stamp, and

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- said message include said issue number (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

18. As per claims 4, 11, and 18, Lee and Pierce teach all the limitations of claims 2, 9, and 15 further;

What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- said verifying means verifies whether said digital certificate making electronic revenue stamp invalid is valid or not, by using said identifier of said receiver and an issue number of said electronic revenue stamp issuing apparatus (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

19. As per claims 5, 12, and 19, Lee and Pierce teach all the limitations of claim 2, further;

What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- invalid electronic revenue stamp data for storing data of electronic revenue stamps made to be invalid (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more

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efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

20. As per claims 6, 13, and 20, Lee and Pierce teach all the limitations of claims 1, 8, and 14 further;

What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- an issued electronic revenue stamp recording means which records issued electronic revenue stamps (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53); and
- storing means for issued electronic revenue stamp data and invalid electronic revenue stamp data (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

21. As per claims 7, 14, and 21 Lee and Pierce teach all the limitations of claims 2, 9, and 15 further;

What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- said verifying means verifies that said digital certificate making electronic revenue stamp invalid is issued for an electronic revenue stamp issued by said electronic revenue stamp issuing apparatus and also issued by a receiver who is a valid receiver of said electronic revenue stamp, and also verifies that said digital certificate making electronic revenue stamp invalid was not used before (See Pierce abstract, figures 1 and 2 along with the

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associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

22. As per claim 22, Lee and Pierce clearly teach all the limitations of claim 15, further;

Lee discloses,

- said program storage device storing said control program of said electronic revenue stamp issuing method is an IC card (See Lee figures 1, 2, 3 and 7 and associated text, abstract, and column 5, line 20-68, column 6, lines 1-68 and column 7, lines 1-64).

23. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

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Conclusion

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (571) 272-6702. The examiner can normally be reached on 9 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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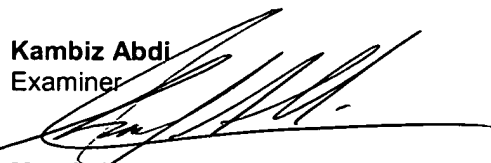
(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

Kambiz Abdi
Examiner



March 15, 2005